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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,801	12/15/2000	William J. Beyda	00 P 9081 US	2375

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Siemens Corporation
Attn: Elsa Keller, Legal Administrator
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

EXAMINER

SHELEHEDA, JAMES R

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/26/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/738,801

Applicant(s)

BEYDA, WILLIAM J.

Examiner

James Sheleheda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Budge et al. (Budge) (6,014,689) (of record).

As to claim 19, note the Budge et al. reference that discloses an email system with a video email player that allows easy video capturing, storage, and transmission of media via email attachments. The claimed “a video input device for capturing a video file” is met by video input device 20 as illustrated in Figure 1. The claimed “and a Web Access device including an e-mail module, said Web Access device configured to receive said video file from said video input device” is met by “[t]he video input device 20 can be any image source, such as one of many types of video cameras... Some type of video input devices may require video capture electronics 22 which are typically contained on a single board within the PC enclosure 12 and mated with the bus provided on the PC motherboard” (Budge 3:38-45) and “FIG. 2 illustrates the preferred embodiment of the environment in which the video e-mail software for the sending sub-

system 2 and receiving sub-system 4 resides, as shown in FIG. 2B" (Budge 4:23-28) wherein the Web Access device has access to a network (Budge 4:15-19). In regards to the "automatic opening of a compose window", (see Budge at Figs. 7A-7B and column 6, lines 19-29, as prompts for composing the email are automatically displayed to the user as part of the email building process.

Also note the Budge et al. reference teaches "attach...said video to an e-mail message" using the videolink software seen in Fig. 6, seen at 720 of Fig. 7A, and taught in col. 2:11-27 as well as throughout the specification. "The sending user 710 receives prompts and provides inputs to the sending system 720 with respect to controlling the virtual VCR, embedding the video e-mail player 220 into the video e-mail message file 500, and controlling the Email client. The sending system 720 creates and transmits a video e-mail message to the receiving system 730" (Budget et al. 6:21-27). "wherein the video email command signal identifies a beginning of a capture of a video clip" the record button is used to begin the capture process and the video email crafting process (see Budge at Fig. 7A and column 5, line 61-column 6, line 29).

As to claim 20, Budge discloses wherein an end of a clip is identified via a manual end of clip command (stop button, see Budge at column 5, lines 61-67).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 and 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budge in view of Liwerant et al. (US 2005/0246752 A1) (of record).

As to claim 1, note the Budge et al. reference teaches an email system with a video email player that allows easy video capturing, storage, and transmission of media via email attachments. The claimed "playing a video on a video input device" is met by playing a video received from the video capture electronics 22, in Figure 1 from camera 20, on a PC 10 (Budge).

The claimed "receiving an activate signal" is met by "[t]o begin recording a video e-mail message, the RECORD button 610 is 'pressed,' that is, activated with a point and click operation of a mouse device, for example" (Budge 5:61-63). The claimed "digitizing and storing at least a portion of said video" and "compressing said at least a portion of said video; storing said at least a portion of said video" is met by during a record process as is well known and taught in col. 4:25+. Video email recorder 210 of Fig. 2 first stores files as a temporary file, which is compressed as claimed (col. 4:47-57). Input may then be provided to store the compressed file to a hard drive, as taught in col. 5:52+ through col. 6:3. The claimed "receiving a deactivate signal" is met by "[t]he MAIL button 670 is pressed to immediately send a recorded message" (Budge 6:15-16) which results in a "deactivation" of the recording session and transition to a "mail" session. The claimed "and automatically accessing said at least a portion from memory and attaching said at least portion of said video as an attachment to an e-mail

message” is met by a user may then desire to launch an email application which will automatically access memory and “attach...said video to an e-mail message” using the videolink software seen in Fig. 6, seen at 720 of Fig. 7A, and taught in col. 2:11-27 as well as throughout the specification.

Note the Budge et al. reference teaches “attach...said video to an e-mail message” using the videolink software seen in Fig. 6, seen at 720 of Fig. 7A, and taught in col. 2:11-27 as well as throughout the specification. “The sending user 710 receives prompts and provides inputs to the sending system 720 with respect to controlling the virtual VCR, embedding the video e-mail player 220 into the video e-mail message file 500, and controlling the Email client. The sending system 720 creates and transmits a video e-mail message to the receiving system 730” (Budget et al. 6:21-27). However, the Budget et al. reference does not specifically disclose whether or not the attachment process is performed in the absence of user interaction and automatically opening an e-mail compose window. Now note the Liwerant et al. reference that discloses a method and system for sharing video over a network. The claimed “launching an e-mail” is met by “[s]haring the video via email will bring up the user’s default email browser, such as Outlook, Netscape Communicator, Eudora, etc... In one embodiment, this ‘embedded video mail’ feature causes a window such as that depicted in FIG. 9 to appear, for example when the user is using Microsoft Outlook for e-mail service” (Liwerant [0117]). The claimed “[attaching said at least a portion of said video as an attachment to an e-mail message] without user interaction” is met by the automatic attachment of the video images to the e-mail compose window as illustrated in Figure 9 (Liwerant [0117]).

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Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Budge et al. video e-mail system with the Liwerant et al. automatic attachments in a email compose window for the purpose of reducing the complexity of sending and receiving audio visual e-mail messages to a level that allows a user to send and receive audio visual e-mail without inconvenience. Note, the claimed "application responsive to said deactivate signal" is met by the Budge et al. and Liwerant et al. combination as discussed above wherein the "deactivation" of the recording session results in the launching of an e-mail application. The claimed "and automatically accessing said at least a portion from memory and attaching said at least a portion of said video as an attachment to an e-mail message without user interaction"

As to claim 2, the claimed "user selecting a compression method" is not taught by Budge. Budge clearly teaches compression techniques for the video data as previously noted, but not allowing a user to select a compression method. Nevertheless, the Examiner takes Official Notice that it was notoriously well known in the art at the time the invention was made to allow selection of a compression method. It would have been obvious for one skilled in the art at the time of the invention to modify the system and methods of Budge by allowing user selected compression methods in order to allow versatility in storage and transmission formats to ensure proper playback.

As to claim 3, the claimed "receiving a deactivate signal...responsive to a timeout of a timer" is not taught by Budge. Nevertheless, the Examiner takes Official Notice that it was notoriously well known in the art at the time of the invention to use a timer as a deactivate signal. It would have been obvious for one skilled in the art at the time of the invention to modify the system and method of Budge by using a timer deactivate signal in order to simplify user tasks.

As to claim 4, note the Budge et al. reference that discloses an email system with a video email player that allows easy video capturing, storage, and transmission of media via email attachments. The claimed "a video input device for generating video images" is met by video input device 20 as illustrated in Figure 1. The claimed "a monitor for displaying said video images" is met by monitor 14 as illustrated in Figure 1. The claimed "and a Web Access device including an e-mail module, said Web Access device configured to receive video images from said video input device" is met by "[t]he video input device 20 can be any image source, such as one of many types of video cameras... Some type of video input devices may require video capture electronics 22 which are typically contained on a single board within the PC enclosure 12 and mated with the bus provided on the PC motherboard" (Budge 3:38-45) and "FIG. 2 illustrates the preferred embodiment of the environment in which the video e-mail software for the sending sub-system 2 and receiving sub-system 4 resides, as shown in FIG. 2B" (Budge 4:23-28) wherein the Web Access device has access to a network (Budge 4:15-19). Also note the Budge et al. reference teaches "attach... said video to an e-mail

message" using the videolink software seen in Fig. 6, seen at 720 of Fig. 7A, and taught in col. 2:11-27 as well as throughout the specification. "The sending user 710 receives prompts and provides inputs to the sending system 720 with respect to controlling the virtual VCR, embedding the video e-mail player 220 into the video e-mail message file 500, and controlling the Email client. The sending system 720 creates and transmits a video e-mail message to the receiving system 730" (Budget et al. 6:21-27). However, the Budget et al. reference does not specifically disclose whether or not the attachment process is performed in the absence of user interaction and automatically opening an e-mail compose window. Now note the Liwerant et al. reference that discloses a method and system for sharing video over a network. The claimed "and automatically open an e-mail compose window" is met by "[s]haring the video via email will bring up the user's default email browser, such as Outlook, Netscape Communicator, Eudora, etc... In one embodiment, this 'embedded video mail' feature causes a window such as that depicted in FIG. 9 to appear, for example when the user is using Microsoft Outlook for e-mail service" (Liwerant [0117]). The claimed "and attach, without use interaction, said video images to the e-mail compose window responsive to a video e-mail command signal for transmission as an attached e-mail file" is met by the automatic attachment of the video images to the e-mail compose window as illustrated in Figure 9 (Liwerant [0117]).

Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Budge et al. video e-mail system with the Liwerant et al. automatic attachments in a email compose window for the purpose of reducing the complexity of sending and receiving audio visual e-mail

messages to a level that allows a user to send and receive audio visual e-mail without inconvenience.

As to claim 5, the claimed "said video e-mail command signal comprising a signal from a switch associated with said video input device" is met by user interaction via keyboard 18 and / or command signals inherent to the operation of PC 10 control operation of system 2 (Budge, see Figure 1).

As to claim 6, the claimed "said video e-mail command signal comprising a signal from a remote control switch associated with said video input device" is met by keyboard 18 and / or mouse 19 including GUI (Budge, see Figure 6 and 5:52-67).

As to claim 7, the claimed "said video e-mail command signal comprising a signal from a graphical user interface" is met by selecting a program for operation and controlling using the GUI seen in Figure 6 (Budge).

As to claim 9, the claimed "wherein said Web Access Device comprises a personal computer" is met by PC 10 of Figure 1 (see Budge et al.).

As to claims 10-15, please see rejections of claims 4-9 respectively.

As to claim 16, please see rejection of claim 4. Also note, the claimed "a local area network" is met by "[t]he communications link 8 may be any of a variety of communications channels which allow the transfer of digital data, such as...local area networks (LANS)" (Budge 4:15-19). The claimed "a video e-mail system coupled to said local area network" is met by Figure 1 of the Budge et al. reference where it is seen that this system is coupled to a "local area network" comprising multiple systems 2 and 4.

As to claims 17 and 18, the claimed sending an email to "another entity on said LAN" or to "an entity external to said LAN" is taught in col. 4:5-19 wherein video e-mail systems are connected via a variety of networks for receiving and transmitting video e-mails.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Budge et al. (US 6,014,689 of record) in further view of Liwerant et al. (US 2005/0246752 A1) and Ludwig et al. (US 2005/0144284 A1 of record).

As to claim 8, note the Budge et al. reference discloses a monitor 14 as illustrated in Figure 1. However, the Budge et al. reference does not specifically disclose "wherein said monitor is a television screen." Now note the Ludwig et al. reference that discloses scalable networked multimedia system and applications. The claimed "wherein said monitor is a television screen" is met by a television may be substituted for a work station (Ludwig [0108]). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Budget et al. monitor with the Ludwig et al. television display in

order to provide users with a more encompassing unit and reduce costs associated with owning multiple devices to watch television and use e-mail.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Budge.

As to claim 3, the claimed "wherein an end of clip is identified as a predetermined default end of clip period" is not taught by Budge. Nevertheless, the Examiner takes Official Notice that it was notoriously well known in the art at the time of the invention to use a timer as a deactivate signal. It would have been obvious for one skilled in the art at the time of the invention to modify the system and method of Budge by using a timer deactivate signal in order to simplify user tasks.

Response to Arguments

7. Applicant's arguments filed 10/16/06 have been fully considered but they are not persuasive.

On pages 6 and 7, of applicant's response, applicant argues that Liwerant and Budge fail to disclose automatically attaching video to the email.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, Budge discloses capturing a video and attaching the video to an email. As the user indicates when to attach the video, Budge was cited as failing to disclose the automatic attachment of the video. Liwerant discloses a video email system wherein the email is automatically created so as to provide a simpler, more user friendly system. Thus it is the combination of Budge and Liwerant which teach the claimed invention, as Budge discloses attaching video to an email and Liwerant discloses the benefits of the automatic system.

Furthermore, applicant is incorrect in the characterization of Liwerant, as Liwerant specifically discloses wherein the email can contain an embedded player which is **preloaded** with the video (see Liwerant at paragraphs 110 and 118), and thus, is not limited to emailing a URL linking to the video.

Finally, applicant has provided no specific arguments in regards to claims 19-21, however, as indicated in the rejections above, it is noted that Budge reads upon these claim limitations.

Conclusion

8. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information

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and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. () _____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (571) 272-7357. The examiner can normally be reached on 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Sheleheda
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